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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,117	04/25/2000	David L Patton	81003F-P	9422

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PATENT LEGAL STAFF
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EXAMINER

KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,117

Applicant(s)

PATTON ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 14-15, 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-9, 14, 15 and 21-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 14, 21-24 are drawn to a method of printing, classified in class 358, subclass 3.28.
 - II. Claims 9 and 15 are drawn to an authentication document, classified in class 283, subclass 73.
 - III. Claims 10-13, 16-20 are drawn to a method of authenticating a document, classified in class 340, subclass 5.86.
2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, invention I can be used to print a document other than invention II, such as ordinary landscape images.
3. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, invention II can be used for age verification purposes.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Frank Pincelli (Registration No. 27,370) on Monday, January 27, 2003, a provisional election was made with traverse to prosecute the invention of III, claims 10-13, 16-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9, 14-15, and 21-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

6. Claim 12 is objected to because the phrase "the holder of said passport" in lines 1-2 lacks antecedent basis. It appears that the applicant intended the phrase to read "the holder of said authentication document." Appropriate correction is required. ✓

Claim 16 is objected to because of the following informalities: grammatical errors. The phrase "said media further and including that a visible indicia" in lines 4-5 is grammatically incorrect. Appropriate correction is required. 

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Claim 17 is objected to because the phrase "said first indicia" in line 5 lacks antecedent basis. It appears that the applicant intended the phrase to read "said indicia". The objection is also applicable to claim 19. Appropriate correction is required. X

Claim 17 is object to because of the following informalities: grammatical errors. The phrase "unique ID associated with and an image of the recipient" in line 6 is grammatically incorrect. It appears that the applicant intended the phrase to read "unique ID associated with an image of the recipient" as disclosed in lines 16-18 on page 10 of the applicant's specification. The objection is also applicable to claim 19. Appropriate correction is required. ✓

Claim 20 is a substantial duplicate of claim 18. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). ✓

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 10, the limitation "a third indicia... comprising a unique ID associated with the captured device used to capture said image" in lines 10-12 renders the claim indefinite because it appears to be a repeat of the previous limitation "a second indicia... comprising a

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unique ID associated with the capture device used to capture said image” in lines 7-9. For examination purposes, the limitation will be interpreted to mean a third indicia comprising a unique ID associated with a printer used to produce a hardcopy, as disclosed in lines 15-17 on page 8 of the applicant’s specification.

Claim 10 recites the limitation "said printer ID" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Referring to claim 10, the phrase “comparing said unique ID” in line 15 renders the claim indefinite because it is unclear which “unique ID” is being claimed.

Claim 10 recites the limitation "said designated location or device" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Referring to claim 11, the phrase “comparing said unique ID” in line 3 renders the claim indefinite because it is unclear which “unique ID” is being claimed.

Claims not mentioned specifically depend from indefinite antecedent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Carr et al., U.S. Patent No. 6,389,151 ("Carr").

Referring to claim 13, Carr discloses a method for verifying that the holder of an authentication document is the holder to which the authentication document was issued (col. 1, lines 20-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Carr et al., U.S. Patent No. 6,389,151 ("Carr"), and Zdybel et al., E.P. 0459792 ("Zdybel").

Referring to claim 10 as best understood, Carr discloses a method of verifying that the presenter of an authentication document is the same individual associated with the authentication document, comprising the steps of:

a. providing an image (12) on the authentication document (10), the image including a first indicia which is not visible under normal viewing conditions, the first indicia comprising a unique ID associated with the holder of the authentication document (col. 3, line 44-col. 4, line 14)

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- b. scanning the image so as to obtain the unique ID (col. 4, line 60-col. 5, line 10)
- c. comparing the unique ID with a known database for confirming that the image matches (col. 5, lines 11-18).

Carr fails to teach a second indicia which is invisible under normal viewing conditions, that comprises a unique ID associated with the capture device used to capture the image, and a third indicia which is not visible under normal viewing conditions, that comprises a unique ID associated with a printer.

Zdybel teaches an image that includes an indicia which is invisible under normal view conditions (col. 9, line 57-col. 10, line 34), that comprises a unique ID associated with the capture device used to capture the image (col. 6, lines 10-19. Note that the “data characterizing the input scanner” in lines 13-14 is interpreted to mean the unique ID associated with the capture device). Zdybel also teaches an indicia which is invisible under normal view conditions that comprises a unique ID associated with a printer used to produce a hardcopy print of the image (col. 5, lines 51-58. Note that the “identification of the machine which performed that print” is interpreted to mean a unique ID associated with a printer).

Zdybel also teaches scanning the image so as to obtain the unique capture and printer ID (col. 12, line 58-col. 13, line 9).

Carr and Zdybel are both concerned with verifying authentication documents. Zdybel provides a relatively straightforward and reliable method for capturing and communicating data defining the equipment and process employed to prepare the document (Zdybel, col. 13, lines 10-25). Therefore, it would have been obvious to combine the teachings of Carr and Zdybel, to

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obtain a first, second, and third indicia that comprises a unique ID associated with the holder, the capture device, and the printer respectively.

Referring to claim 11 as best understood, Carr further discloses sending the information obtained by scanning the image to a remote database whereby information relating to the unique ID can be viewed and confirmed (col. 5, lines 18-25).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Carr et al., U.S. Patent No. 6,389,151 ("Carr"), and Zdybel et al., E.P. 0459792 ("Zdybel"), further in view of Cadorette, Jr. et al., U.S. Patent No. 6,341,169 ("Cadorette").

Referring to claim 12 as best understood, the combination of Carr and Zdybel fail to disclose that the holder of the authentication document is viewed by a camera at presentation so as to obtain an image of the presenter.

Cadorette discloses a method for verifying a holder of an authentication (credential) document wherein the holder is viewed by a camera at presentation so as to obtain an image of the presenter, the image being forwarded to a location for comparison with a database to confirm that the individual is associated with that authentication document (col. 11, lines 52-65 and col. 13, lines 6-18).

Carr, Zdybel, and Cadorette are all concerned with verifying authentication documents. Cadorette's method provides convenience to an evaluating party by automatically comparing the image on the document with an image of the presenter at the time of evaluation in order to establish a reliable measure of verification (Cadorette, col. 2, line 60-col. 3, line 2). Therefore, it

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would have been obvious to include the image of the presenter, as taught by Cadorette, in the method of Carr and Zdybel.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rhoads, U.S. Patent No. 5,841,886 ("Rhoads"), and Piosenka et al., U.S. Patent No. 4,993,068 ("Piosenka").

Referring to claim 16 as best understood, Rhoads discloses a system for monitoring and verifying that the presenter of an authentication document is the individual to which the authentication document was issued, comprising the steps of:

a. capturing an image (1010) and printing it onto a media (1000) the media further including a visible indicia (barcode) printed on the image on the media which can be used for authenticating the individual to which the document has been issued (col. 6, lines 44-63. Rhoads teaches that the indicia can be visibly printed on the image, see col. 8, lines 6-15),

b. a scanner for scanning of the document and providing the information to a remote locality (col. 7, lines 12-29. Note that the "photo ID reading device" and "central network" in lines 15-18 are interpreted as a scanner and remote locality, respectively).

Rhoads fails to teach a camera for capturing the presenter of the document at a remote location, and a scanner for scanning information from the document and transmitting it to a remote location for further verifying the presenter.

Piosenka teaches a method for verifying a presenter of an authentication document (4) that includes a camera (31) for capturing the presenter of the document at a remote location capable of confirming the identity of the individual (col. 8, lines 33-47). Piosenka also teaches a

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scanner (35) for scanning information from the authentication document (col. 8, lines 10-32) and transmitting the information to the remote location such that further verifying information can be called up at the remote location for verifying the presenter (col. 8, lines 48-61).

Rhoads and Piosenka are both concerned with verifying authentication documents. Piosenka's verification process is simple and inexpensive (Piosenka, col. 8, lines 35-39). Therefore, it would have been obvious to modify the system of Rhoads so that it includes the camera and scanner of Piosenka.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, U.S. Patent No. 5,841,886 ("Rhoads").

Referring to claim 17 as best understood, Rhoads discloses a method for verification comprising:

a. an authentication document (950) having an image of the individual to which the authentication was issued (col. 2, line 64-col. 3, line 8) and an indicia which is not visible under normal viewing conditions, the indicia comprising a unique ID associated with an image of the recipient to which the authentication document was issued (col. 1, lines 59-67. Note that the "multi-bit data related to the photograph" in lines 61-62, is interpreted as being analogous to the indicia comprising a unique ID associated with the image), the unique ID and the image being digitally stored at a data base [col. 3, lines 19-22 and col. 4, lines 34-36. Note that the central network (980) is interpreted to mean the data base for storing the image and the unique (information) ID],

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b. presenting the authentication document at a remote location by a presenter and scanning the image at the remote location so as to obtain the unique ID [col. 4, line 55-col. 5, line 3. Note that scanning the document (950) at the remote (point-of-sale) location inherently includes the step of presenting the document by a presenter because the document must be obtained from the presenter before it is scanned], and

c. forwarding the unique ID electronically to the data base (col. 5, lines 18-28).

Rhoads further states that his method can be used in any photographic based identification system in order to verify that the presenter of the authentication document is the same individual to which the authentication document was issued (col. 6, lines 44-57 and col. 7, line 13-col. 8, line 5).

Rhoads does not explicitly state that the image stored in the data base is forwarded to the remote location in response to the received ID for verification that the presenter is the same as the individual to which the authentication document was issued. However, Rhoads teaches that the images stored in the data base (central network) is “made available” to all the remote (point-of-sale) locations in the network (col. 4, lines 38-40). Therefore, since the images are “made available” to the remote locations, it would have been obvious to forward the images from the data base to the remote locations in response to the received ID to verify the presenter.

13. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, U.S. Patent No. 5,841,886 (“Rhoads”) as applied to claim 17, further in view of Zdybel et al., E.P. 0459792 (“Zdybel”).

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Referring to claims 18 and 20, the claim's use of "or" between the three limitations only requires the prior art to meet either one of the three limitations. In this case, Rhoads fails to teach that the unique ID includes information regarding the capture device.

Zdybel teaches an image that includes an indicia that is invisible under normal view conditions (col. 9, line 57-col. 10, line 34), that comprises a unique ID associated with the capture device used to capture the image (col. 6, lines 10-19. Note that the "data characterizing the input scanner" in lines 13-14 is interpreted to mean the unique ID associated with the capture device).

Rhoads and Zdybel are both concerned with verifying authentication documents. Zdybel provides a relatively straightforward and reliable method for capturing and communicating data defining the equipment and process employed to prepare the document (Zdybel, col. 13, lines 10-25). Therefore, it would have been obvious to modify the unique ID of Rhoads so that it includes information regarding the capture device, as taught by Zdybel.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cadorette, jr. et al., U.S. Patent No. 6,341,169 ("Cadorette"), further in view of Rhoads, U.S. Patent No. 5,841,886 ("Rhoads").

Referring to claim 19, Cadorette discloses a method of verifying that the presenter of an authentication (credential) document is the same individual to which the authentication document was issued;

a. the authentication document having image of the individual to which the authentication document was issued and an indicia comprising a unique ID associated with an

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image of the recipient to which the authentication document was issued [col. 12, lines 35-44.

Note that the “encoded data” in line 43 is interpreted to mean an indicia comprising a unique ID associated with an image of the recipient, since it is used to retrieve the “verification reference record” (col. 13, lines 3-4). Cadorette teaches that the verification reference record contains image data of the individual identified by the document (col. 13, lines 9-16)], the unique ID and the image being digitally stored at a data base (col. 12, lines 55-58)

b. presenting the authentication document at a remote location by a presenter and scanning the image at the remote location to obtain the unique ID (col. 12, lines 8-25. Note that the unique ID is obtained once the document is optically detected, see col. 12, lines 41-43)

c. capturing a live image of the presenter at the time of presentation (col. 11, lines 52-65)

d. forwarding the unique ID and the live image electronically to the data base, and comparing the stored image associated with the unique ID with the live image for verification that the presenter is the same as the individual to which the authentication document was issued (col. 13, lines 6-17).

Cadorette fails to teach that the indicia is not visible under normal viewing conditions.

Rhoads teaches an image with an indicia that is not visible under normal viewing conditions (col. 1, lines 59-67).

Cadorette and Rhoads are both concerned with verifying authentication documents. Rhoads’s method enhances the security associated with the use of photo ID documents (Rhoads, col. 7, lines 4-5). Therefore, it would have been obvious to modify the indicia of Cadorette so that it is not visible under normal viewing conditions, as taught by Rhoads.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- a. Schwab U.S. Patent No. 5,973,731 discloses a secure identification system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Monday thru Thursday 8:30am to 6:00pm and alternating Fridays 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

ck
ck
January 30, 2003


Jon Chang
Primary Examiner